



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/888,609	07/07/97	HEUER	L BAYER-8890-3

HM42/0707
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EXAMINER

CLARDY, S

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 07/07/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/888,609

Applicant(s)

Heuer et al

Examiner

S. Mark Clardy

Group Art Unit

1616



☒ Responsive to communication(s) filed on Apr 20, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 12-19 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 12-19 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Claims 12-19 are pending in this application. All previously pending claims were canceled in Amendment H filed April 20, 1998.

Applicants' claims are drawn to methods of protecting wood against wood destroying or discoloring fungi by application of cyproconazole (claims 12, 16), optionally in combination with additional active agents (tebuconazole, imidacloprid: claims 13, 17, and 14, 18, respectively), and a wood containing product so protected (claims 15 and 19).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15 and 19 are again rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims, based upon previously rejected claim 11, are improper in claiming products that merely contain the claimed active ingredient. Applicants argue that these claims, drafted as product-by-process claims are in acceptable form. However, determination of patentability in "product-by-process" claims is based on the product itself, even though such claims are limited and defined by the process, and thus the product in such a claim is unpatentable if it is the same as, or is obvious from, the product of the prior art, even if the prior product was made by a different process. In re Thorpe, et al. 227 USPQ 964

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-19 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Schaub (A) in view of Ludwig et al (A'), and EP 0 393 846 (L'), all of record.

Schaub, again, teaches that cyproconazole is an old fungicide employed with carriers of the type claimed. Applicants argue that Schaub teaches utility against phytopathogenic fungi, and that it does not necessarily follow that there would be expected utility against wood destroying or discoloring fungi. Note, however, that activity against phytopathogenic fungi in agricultural applications is disclosed, as well as utility as pharmaceutical and veterinary antifungal agents (column 4, lines 53-68). It is not necessary that a reference disclose antifungal activity for an antifungal compound against every conceivable fungus in order for it to be seen as an obvious agent to use for treating any kind of fungus. Thus it would appear that cyproconazole was known as a generally active antifungal agent with utility against a variety of classes of fungi, not just those of a phytopathological nature. One skilled in the art of antifungal agents would thus expect activity against fungi, particularly within the specific classes disclosed in Schaub (column 5). While applicants' specifically claimed secondary active agents are not explicitly disclosed, it is noted that they are well known in the pesticidal art; further, Schaub also discloses formulation with additional active agents including fungicides and insecticides (column 7, lines 10-23).

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The EPO reference and the Ludwig et al reference, again, teach that triazoles of the type claimed are old fungicides employed with carriers of the type claimed and effective against wood fungi.

Therefore, again, one skilled in the art would find ample motivation from the prior art, above, to use cyproconazole as a fungicide against wood destroying or discoloring fungi with a reasonable expectation that it would be effective. Applicants' additional active agents are known pesticidal agents (tebuconazole, fungicide; imidacloprid, insecticide), thus their combination with cyproconazole is conventional. It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose in order to form a third composition that is to be used for the very same purpose; the idea of combining them flows logically from their having been individually taught in the prior art. In re Kerkhoven, 205 USPQ 1069. There is nothing inventive in a composition of old ingredients of known properties with each ingredient functioning individually as expected. In re Sussman. 58 USPQ 262.

Applicants again point to the Kugler declaration as presenting unobvious or unexpected results. Any fungicide will be expected to exhibit some degree of variation in its spectrum of activity. Again, cyproconazole is a conventional fungicide, used herein in a conventional manner.

No claim is allowed.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made

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in order for the examiner to consider the applicability of 35 U.S.C. 103 and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Al Robinson, who remains the primary examiner for this application, but is currently unavailable. His telephone number is (703) 308-4524.

A handwritten signature in black ink, appearing to read "S. Mark Clardy". The signature is fluid and cursive, with a large initial "S" and a stylized "C" at the end.

S. Mark Clardy
Primary Examiner
AU 1616

July 6, 1998